

Serial No. 09/917,792
Atty. Docket No. 50442.010200
Response to Non-final Office Action

REMARKS

Claims 1-24 and 26 are pending in the present application. Applicant notes with appreciation the Examiner's withdrawal of the previous claim objections and the rejection of claims 1-5, 8, 10-15 and 26 under 35 U.S.C. § 103.

Claim Rejections - § 112

Previously numbered claim 23 has been renumbered as claim 22 in accordance with the Examiner's suggestion.

Claim Rejections - § 102

Claims 1-5, 8, 10-15 and 26 stand are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,759,101 to Von Kohorn (hereinafter "Von Kohorn").

Applicants respectfully traverse the rejections in their entirety.

Applicants' discussion of the fundamental differences between the claimed invention and Von Kohorn are set forth in the Response to the prior Office Action; that discussion and the related arguments are incorporated herein by reference and will not be repeated except that Applicant notes again that Von Kohorn discloses a method of allowing interaction by a remote audience in a broadcast, such as a game show, while the present invention is aimed at the need to measure the *effectiveness* of advertisers' ads in the context of the programs in which they are aired and to obtain accurate, continuous data on the *performance* of ads.

Applicants strongly disagree with the Examiner's characterization of the teaching of Von Kohorn with respect to Applicants' claimed first and second sets of questions stored in a

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computer system, and particularly the selection of subsets thereof. In this respect, Applicant's claim 1 recites the following:

...storing in a computer system a first set of trivia questions relating to
advertising content;
storing in said computer system a second set of trivia questions relating to
show content;
associating said first and second sets of trivia questions with a broadcast of
said advertising content along with said show content;
selecting a subset of said first set of trivia questions and a subset of said
second set of trivia questions to ask a member...

Independent claims 12, 14 and 15 include similar limitations. It is noted here that Applicant has amended independent claims 1, 12, 14 and 15 to clarify the "selecting" step. In particular, Applicant has clarified that this selection is a selection of a subset of the show content questions and a subset of the ad content questions.

Von Kohorn fails to teach or fairly suggest selecting a subset of the first and second sets of trivia questions to ask a member. While the Examiner cites FIG. 28 as disclosing Applicant's claimed "selecting a subset..." element, Applicant disagrees. FIG. 28 relates to selection of a shopper's area of interest, and fails to teach or fairly suggest selecting a subset of first trivia questions related to show content and a subset of second trivia questions relating to advertising content to ask a member. To the contrary, in accordance with the description of FIG. 28 at column 88, lines 58-59, "program material including questions and product listings

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are televised,” which would require that viewers receive all questions. At column 44, lines 55-67, he states further that questions are either asked by a television host or visually posed to the television viewers, which would also require that such television viewers receive all questions. This is inconsistent with Applicant’s claimed step of selecting a subset of the first and second sets of trivia questions to ask a member.

Moreover, Von Kohorn fails to teach or fairly suggest storage in a computer system of first and second sets of trivia questions relating to advertising content and show content, respectively, at all. The Examiner cites column 44, line 55, to column 45, line 5, of Von Kohorn as disclosing storage in a computer system of the first set of questions, and cites column 2, lines 42-59, of Von Kohorn as disclosing storage in a computer system of the second set of questions. While Von Kohorn discloses storage of data entered by a respondent in a computer system, he fails to teach or fairly suggest the storage in a computer system of these two sets of questions. Applicants see nothing in the two cited portions, or elsewhere in Von Kohorn, that teaches or fairly suggests storage in a computer system of Applicants’ claimed first and second sets of questions. In this respect, Von Kohorn states at column 44, lines 55-67, that his questions are either asked by a host or visually posed to the television viewers by displaying the questions on electronic boards or on other display means. Von Kohorn goes on to state that, alternatively the host may silently point to an advertised item of merchandise to insure that participants are paying attention. In each case, the disclosure of Von Kohorn fails to teach or fairly suggest storage in a computer system of first and second sets of trivia questions relating to advertising content and show content, respectively. Even if Von Kohorn’s “electronic board” or the like were to be construed as a computer system (and Applicants assert that it is not), Von Kohorn would at best disclose storing only a *single set of*

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questions, not a first set relating to advertising content *and* a second set relating to show content.

With respect to dependent claim 26, Von Kohorn additionally clearly fails to teach or suggest Applicants' claimed invention wherein the transmitting step is performed at a time after the broadcast. At column 44, lines 55-67, Von Kohorn states further that questions are either asked by a television host or visually posed to the television viewers, which would require the questions to be transmitted during the broadcast.

In view of all of the above, Von Kohorn clearly fails to teach or suggest specific elements set forth in claims 1-5, 8, 10-15 and 26. The Court of Appeals for the Federal Circuit has consistently held that "Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick, 221 USPQ 481, 485 (Fed. Cir. 1984). Von Kohorn clearly fails to teach or suggest structure positively recited and claimed in Applicants' independent claims. Thus, Applicants' invention is patentable over Von Kohorn, and the anticipation rejection under § 102 should be withdrawn.

Claim Rejections - § 103

Claims 6-7, 9, and 16-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Von Korn. This rejection is respectfully traversed in its entirety.

Applicants note the amendments to the independent claims as discussed above. The above arguments that Von Kohorn fails to teach or suggest limitations set forth in Applicants' independent claims are incorporated herein in response to the § 103 rejection and will not be repeated here. Additionally, patentable features of claims 6-7, 9 and 16-24 are set forth below.

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With respect to claims 6 and 7, claim 6 requires that the broadcast comprises a display of multimedia content via an internet connection and claim 7 requires that members' responses to subsets of trivia questions be received via an internet connection. While the Examiner asserts that Von Kohorn's disclosure at column 7, lines 11-34 suggests these elements, Applicant disagrees. Von Kohorn discloses therein a "network of broadcast stations", not a network connection comprising an internet connection as claimed. Replacing a "network of broadcast stations" with an internet connection was not well known in the art at the time of the invention or more than one year prior to Applicants' filing date. Further, with respect to claim 7, Von Kohorn's disclosed "network of broadcast stations" fails to teach or suggest using an internet connection to receive members' responses.

With respect to claims 16-19 and 20-24, the Examiner admits that Von Kohorn fails to teach Applicants' claimed steps of scoring member's performance in response to the subset of trivia questions and creating a report indicative of effectiveness of advertising content based at least in part on said member's responses. While the Examiner cites column 44, line 55, to column 45, line 5, and column 135, lines 5-27, of Von Kohorn, in combination with official notice, as suggesting these elements, Applicants strongly disagree. Nothing in the cited portions or elsewhere in Von Kohorn discloses measuring the effectiveness of advertising based upon members' responses to first and second sets of trivia questions. Von Kohorn fails to teach or suggest scoring members responses as an indication of the effectiveness of advertising or creating a report, based upon the responses, indicative of that effectiveness. Thus, Von Kohorn, even when combined with the official notice taken by the Examiner, does not teach or suggest the invention of claims 16-19 and 20-24. It is noted that Applicants have amended claim 16 to clarify the step of creating a report indicative of effectiveness of the

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advertising content. Further, as discussed in detail above with respect to the § 102 rejections, Von Kohorn fails to teach or suggest storing in a computer system first and second sets of trivia questions relating to advertising content and show content, respectively, as required by independent claims 16 and 20.

Thus, in view of the above, claims 6-7, 9, and 16-24 include limitations not taught or suggested by Von Kohorn. It is well established that, in order to show obviousness, all limitations must be taught or suggested by the prior art. In Re Boyka, 180 U.S.P.Q. 580, 490 F.2d 981 (CCPA 1974); MPEP § 2143.03. It is error to ignore specific limitations distinguishing over the references. In Re Boe, 184 U.S.P.Q. 38, 505 F.2d 1297 (CCPA 1974); In Re Saether, 181 U.S.P.Q. 36, 492 F.2d 849 (CCPA 1974); In Re Glass, 176 U.S.P.Q. 489, 472 F.2d 1388 (CCPA 1973). It is therefore requested that the § 103 rejection of claims 6-7, 9, and 16-24 over Von Kohorn be withdrawn.

Conclusion

Applicants respectfully submit that all of the stated grounds of rejections have been properly traversed or rendered moot and believe that all pending claims 1-24 and 26 are allowable over the prior art of record. Thus, it is believed that the present invention is in condition for allowance, and Notice to that effect is respectfully solicited.

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In the event that the Examiner is of the opinion that a brief telephone or personal interview will facilitate allowance of the application, he is courteously requested to contact Applicant's undersigned representative.

Date: December 8, 2005

Respectfully submitted,

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